

**REMARKS**

Claims 1-4, 6, 8, 10-16, 19-21, 23, 24, and 26-138, are pending in the captioned application. In the outstanding Official Action, the Examiner has required restriction of claims 1-4, 6, 8, 10-16, 19-21, 23, 24, and 26-138, to a single species from each of Groups I, II, and III, as follows:

***I. A single disclosed product form:***

- a. Gel;
- b. Solution;
- c. Aerosol, mousse, and foam;
- d. Ointment;
- e. Lotion;
- f. Cream;
- g. Paste;
- h. Shampoo; or
- i. Conditioner.

***II. A single disclosed penetrating agent:***

- a. Alcohol;
- b. Amine;
- c. Carboxylic acid;
- d. Ester;
- e. Azone;
- f. N-methyl pyrrolidone;
- g. Bile salt;
- h. Urea;
- i. Dodecanol alcohol;
- j. Oleyl alcohol;
- k. Isopropyl amine;
- l. Diisopropyl amine;
- m. Triethyl amine;
- n. Disopropanol amine;
- o. Ethylene diamine;
- p. Oleic acid;
- q. Linoleic acid;
- r. Dibutyl sebacate;
- s. Dibutyl phthalate;
- t. Butyl benzoate; or

- u. Ethyl caprate.

**III. A single disclosed co-solvent:**

- a. Glycerol;
- b. 1,3-Butylene glycerol;
- c. Propylene glycol; or
- d. Benzyl alcohol.

**PROVISIONAL ELECTION**

Applicants hereby provisionally elect: I. aerosol, mousse and foam as the product form; II. alcohol as the penetrating agent; and III. glycerol as the co-solvent, with traverse.

Further as required by the examiner Applicants submit that the claims that read upon the elected species are as follows:

- i. Aerosol, mousse and foam: claims 1-4, 6, 8, 10-14, 16, 19-21, 23-24, 26-44, and 112-138;
- ii. Alcohol: claims 1-4, 6, 8, 10-14, 16, 19-21, 23-24, 26-114, and 118-138; and
- iii. Glycerol: claims 1-4, 6, 8, 16, 19-20, 23-24, 26-33, 36-56, 59-76, 79-81, 83-100, 103-105, 107-128, 131-133, and 135-138.

Applicants note that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

**TRAVERSAL**

Applicant respectfully traverses the Examiner's election requirement.

Applicant asserts that the election of species requirement is improper because it does not comply with the criteria for an election of species, as specified in 35 USC 121, 37 CFR 1.141-146, and MPEP 801-818. More specifically, Applicant asserts that there is no support for the election of species requirement because the Examiner has provided no reasoning as to why the asserted species are "independent" or "distinct." That is, the Examiner has neither suggested an example of a separate utility nor has shown separate classification, status, or field of search (MPEP 808.02 (A-C)). In addition, the Examiner has not established that a "serious burden" exists.

MPEP 803 specifies that restriction/election between two groups of claims is only proper when (1) one group of claims is independent *or* distinct from another group of claims and (2) a "serious burden" exists on the examiner in examining both groups of claims. Two or more species are independent if there is no disclosed relationship between them, i.e., they are unconnected in design, operation, or effect (MPEP 802.01). Two or more species are distinct if, as disclosed, they are related but are capable of separate manufacture, use, or sale, as claimed and are patentable over each other (MPEP 802.01, 806.05). The Examiner can show a "serious burden" by establishing one of: the inventions are classified separately; the inventions have been classified together, but it can be shown that each subject has formed a separate subject for inventive effort (can cite patents or show a separate field of search); or the inventions require a separate field of search, that is, it is necessary to search for one subject in a place where no pertinent art

for the other subject exists (MPEP 808.02 (c)).

Because the Examiner is alleging that the species are independent and distinct, the Examiner must show that they are independent (i.e., they are unconnected in design, operation, or effect) or must show two-way distinctness and reasons for insisting on restriction, i.e., separate classification, status, or field of search. A showing of two-way distinctness requires that a combination as claimed: (1) does not require the particulars of the subcombination as claimed for patentability; and (2) the subcombination can be shown to have utility either by itself or in other and different relations.

In addition, Applicant asserts that a complete and thorough search of the subject matter described in the provisionally elected species set forth above would require searching the art areas appropriate to all other subject matter contained in this application. Since a search of the subject matter of the provisionally elected species and all other subject matter contained in this application would be coextensive, it would not be a *serious* burden upon the Examiner to conduct a search of *all* subject matter contained in this application.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

**CONCLUSION**

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the election requirement, and to examine all of the species/claims pending in this application.

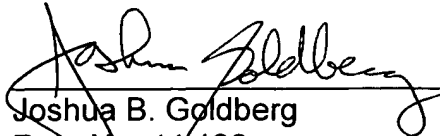
If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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